



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

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APR 30 2003

OFFICE OF PETITIONS

In re Application of :
Bruce Archibald Short :
Application No. 09/987,772 : DECISION REFUSING STATUS
Filed: 15 November, 2001 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 4059/19 :

This is in response to the petition filed on 15 January, 2003,
under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(b)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 15 November, 2001,
without an executed oath or declaration.

Accordingly, on 15 August, 2002, Initial Patent Examination
Division mailed a Notice To File Missing Parts of Nonprovisional
Application requiring the statutory basic filing fee, an executed
oath or declaration and a surcharge for their late filing.

In response, on 15 January, 2003, the present petition was filed,
accompanied by the statutory basic filing fee and the late filing
surcharge, and a declaration naming Bruce Archibald Short as the
sole inventor and signed by Simon Robert Ward, Director, A. Ward
Attachments, Ltd. on behalf of the non-signing inventor. A three
(3) month time extension in accordance with 37 CFR 1.136(a) was

also filed.

Petitioners assert that a copy of the declaration was personally presented to the non-signing inventor, but that the inventor refused to sign it.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (1), (5) and (6).

As to item (1), petitioners have not presented proof that a copy of the application (specification, including claims, drawings, if any, and the Declaration) was sent or given to the non-signing inventor for review. The declaration of Simon Robert Ward does not state whether the application papers were presented to Short prior to the refusal. If the application as filed was presented to Short, any renewed petition should so state.

Alternatively, if the application is sent to the non-signing inventor, petitioner should submit a copy of the cover letter transmitting the application papers to the non-signing inventor at the inventor's last known address or details given in an affidavit or declaration of facts by a person with first-hand knowledge of the details.

If an inventor refuses in writing to sign the declaration, petitioners should submit that written refusal with any renewed petition. If an inventor refuses orally, then the person to whom that oral refusal was made must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (5), petitioners have not established that the Rule 1.47(b) applicant has sufficient proprietary interest in the

subject matter to justify the filing of the application.¹

Petitioners may establish proprietary interest by filing a copy of the employment agreement between the non-signing inventors and the Rule 1.47(b) applicant (company); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

In regards to item (6), petitioner must provide proof of irreparable damages in accordance with MPEP 409.03(g).

The Office is construing Simon Robert Ward's title as "Director" to mean he is a corporate officer of the assignee. If he is not a corporate officer, then proof of his authority to sign on behalf of the corporation must be submitted.²

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

¹MPEP 409.03(f).

²MPEP 409.03(b).